

### **REMARKS**

Claims 1, 16 and 41 have been objected to because the term "substantially immovable" should be further clarified to define how the equipment is constructed with an object in order to make it substantially immovable. Claims 1 – 4, 6 – 7, 10 – 19, 21 – 31 and 33 – 40 have been rejected under 35 U.S.C. §102(b) as being anticipated by Want (U.S. Patent No. 6,008,727). Claims 5, 8 – 9, 20, 32 and 41 – 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Want (U.S. Patent No. 6,008,727). Applicant respectfully traverses these rejections for at least the following reasons.

### **Amendment After Final**

Entry of this Amendment is respectfully requested on the ground that this Amendment places the application in condition for allowance. Alternatively, entry of this Amendment is respectfully requested on the ground that this amendment places the claims in better form and condition for appeal. Furthermore, Applicant submits that any changes made to the claims herein do not require an additional search on the part of the Office, nor do any amendments made herein raise new issues with regard to the patentability of the claims now pending.

### **Examiner's Interview**

Applicant wishes to express appreciation for the Examiner's Interview that occurred on October 10, 2003.

In the interview, Applicant submits that it was agreed that the proposed claim amendments, incorporated herein, would render the 35 U.S.C. §102(b) rejections with respect to Claims 1, 16, 29 and 41 overcome.

More specifically, in the interview, with regard to Want, Applicant submits that it was agreed that Want primarily is designed for loss prevention of preferentially mobile objects, and is definitively for objects for which the location must be tracked, i.e., objects for which the location may not be a known, fixed spatial point. Further, in accordance with Want, such objects must be accessible so that the location of those objects may be assessed.

Thus, as discussed, Want actually teaches away from Applicant's invention, at least in that, as evidenced by the clarifying amendments included herewith, Applicant claims, in relevant part, "a permanently spatially fixed processor and memory device affixed to the substantially immovable equipment, the instructions directly relating to a substantially immovable equipment residing on the memory device", and "wherein said processor processes the instructions to and from said memory device, including processing for forwarding of the instructions from the memory device to said memory reading device".

Therefore, as discussed in the interview, contrary to the teachings of Want, the memory device of Applicant's invention, and hence the equipment to which it is affixed, is located in a known, inaccessible, permanently spatially fixed location.

### **Claim objections**

Claims 1, 16 and 41 have been objected to because the term “substantially immovable” should be further clarified to define how the equipment is constructed with an object in order to make it substantially immovable. Applicant respectfully submits that the present claim objection has been obviated, as discussed hereinabove with respect to the Interview.

### **Claim Rejections Pursuant to 35 U.S.C. §102(b) as being anticipated by Want**

Claims 1 – 4, 6 – 7, 10 – 19, 21 – 31 and 33 – 40 have been rejected under 35 U.S.C. §102(b) as being anticipated by Want (U.S. Patent No. 6,008,727).

Applicant respectfully traverses these rejections for at least the following reasons:

35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless – (b)  
the invention was patented or described in a printed  
publication in this or a foreign country or in public  
use or on sale in this country, more than one year  
prior to the date of application for patent in the  
United States.

Consistently, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

#### Claim 1

Independent Claim 1, as amended, recites:

1. A system for providing instructions directly relating to a substantially immovable equipment at an inaccessible location, comprising:

(A) a permanently spatially fixed processor and memory device affixed to the substantially immovable equipment, the instructions directly relating to a substantially immovable equipment residing on the memory device; and

(B) a portable memory reading device, separate from the memory device, that retrieves the instructions from the memory device and communicates the instructions to a user of said portable memory reading device,

wherein said processor processes the instructions to and from said memory device, including processing for forwarding of the instructions from the memory device to said memory reading device.

Applicant respectfully submits that Want does not teach the claimed elements of Amended Claim 1. Further, Applicant submits that Want teaches

away from the presently claimed invention. Want teaches that “the electronic tags 32 or 42, 44 and 46 are brought near one or more of the tag readers, query/response signals 22 and 24 are passed between the electronic tags and the tag reader, and the identification number of the read electronic tag is passed to the computer system.” Want, col. 6, lines 53-58. Further, Want teaches that “the computer system 12 is used to interpret the identification number of the electronic tag and provide the requested digital service.” Want at Col. 8 line 66 – Col. 9, line 1. Examiner, in the present rejection, states that Applicant’s claim is rendered unpatentable because Want’s electronic tags read on Applicant’s memory device. It is clear that Want teaches a sensing activated system preferentially for goods that are mobile, such as in a theft deterrent system, for example. See Want at Col. 9, lines 22 – 44 and Col. 6, lines 59 – 65.

On the other hand, the present invention claims “a system for providing instructions directly relating to a substantially immovable equipment at an inaccessible location,” including “a permanently spatially fixed processor and memory device affixed to the equipment.” *Amended Claim 1*. As may be seen from the relevant portions of amended Claim 1, Applicants invention embodies a substantially stationary memory device affixed to a substantially stationary location or equipment. Applicant submits that Applicant’s spatially fixed memory device affixed to a substantially immovable equipment at an inaccessible location is thus distinct from Want’s electronic tags that are mobile, at least in that Want is directed principally to movable equipment, and in that Want requires accessibility.

Applicant believes at least these distinctions render Want inapplicable as a reference, as Want teaches away from the present invention.

Applicant further submits that Amended Claim 1 claims “the instructions directly relating to a substantially immovable equipment.” On the contrary, Applicant respectfully submits that Want's instructions do not directly relate to the equipment. Rather, Want's instructions arguably, at best, identify a good by emitting or transmitting a given RF signal. Such a RF signal may be cross-referenced, such as in a remote database, to determine the good identified. In the present invention the instructions transmitted to the portable memory reading device, in fact, contain the instruction that the user of the present system is requesting to receive, and the additional cross-referencing step of Want is neither required nor desired.

Additionally, Amended Claim 1 includes a “wherein said processor processes the instructions to and from said memory device, including processing for forwarding of the instructions from the memory device to said memory reading device.” The present invention includes a device located at the inaccessible location. This device includes the capabilities of processing and memory. On the contrary, the device asserted to read on this device from Want is a RF ID tag. Such a device in Want likely does not qualify as a processor or a memory device, and certainly does not qualify as both. For example, assuming arguendo that an active tag may have a memory for emitting a particular RF ID, or that a passive tag may process incoming RF signals to select a certain frequency to identify the

tag, the present invention performs both functions, and hence is not anticipated by the device of Want.

Applicant further respectfully notes that Applicant's portable reading device as claimed in Claim 1 is distinct from any teachings in Want. Examiner asserts that electronic tag reader 20 as seen and described with respect to Figure 1 teaches Applicant's portable reading device. On the contrary, Want's electronic tag reader is not portable. The disclosure of Want describes an electronic tag reader 20 "connected to a computer system 12, which further includes a local computer 14, database servers 16 and networked computers 18." In the present invention the portable reading device is portable and used by the user to receive instructions. Want thus fails to teach, at least, a portable memory reading device and communicating instructions to a user, and thus Want cannot anticipate claim 1. *See MPEP 2131.*

Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 1 and the dependents therefrom, deems the rejection overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 1 is in a condition for allowance.

Applicant further submits that Want fails to teach, and therefore anticipate, Claims 2-4, 6-7 and 10-15, at least because of these claims' ultimate dependence on patentably distinct base Claim 1. Applicant submits that each of Claims 2-4, 6-7 and 10-15 are similarly in a condition for allowance.

#### Claim 16

As recited hereinabove, Claim 16 recites in part a “portable memory reading device” that “communicates the dedication information to a user of said portable memory reading device.” Claim 16 further recites a “permanently spatially fixed memory device.” As set forth hereinabove, with respect to Claim 1, Want fails to teach a “portable memory reading device,” fails to teach the communication of dedication information to a user, and fails to teach “permanently spatially fixed memory device.” In fact, Want fails to teach any dedication information at all.

Further, as stated with respect to amended Claim 1, Want teaches a theft deterrent system preferentially for goods that are mobile, while the present invention sets forth a substantially stationary memory device affixed to a substantially stationary location or equipment. Applicant further respectfully submits that Want’s instructions do not directly relate to the equipment, but rather Want’s instructions arguably identify a good by emitting or transmitting a given RF signal that is at least one step removed from usable information, while the present invention transmits instructions to the portable memory reading device that in fact contain the very instruction that the user of the present system desires to receive. The present invention includes a device located at the inaccessible location, which device includes the capabilities of processing and memory. In the present



invention the portable reading device is portable and used by the user to receive instructions.

Thus, Want cannot anticipate Claim 16 and the dependents therefrom. *See MPEP 2131*. Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 16, deems it overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 16 is in a condition for allowance.

Applicant further submits that Want fails to teach, and therefore anticipate, Claims 17-19 and 21-28 at least because of these claims' ultimate dependence on patentably distinct base Claim 16. Applicant submits that each of Claims 17-19 and 21-28 are similarly in a condition for allowance.

#### Claim 29

As discussed hereinabove with respect to Claims 1 and 16, Claim 29 recites in part a "portable memory reading device" that communicates with a memory device and "receives the plurality of information for display to the user," and a memory device that is "permanently spatially fixed." Further, as set forth hereinabove with respect to Claims 1 and 16, Want fails to teach a "portable memory reading device," further fails to teach the communication with the memory device and receiving the information for display to the user, and further fails to

teach a permanently spatially fixed memory device. In fact, Want fails to teach the display of any information at all.

Further, as discussed with respect to Claims 1 and 16, Want teaches a theft deterrent system preferentially for goods that are mobile, while the present invention sets forth a substantially stationary memory device affixed to a substantially stationary location or equipment. Applicant further respectfully submits that Want's instructions do not directly relate to the equipment, but rather Want's instructions arguably identify a good by emitting or transmitting a given RF signal, while the present invention transmits the instructions to the portable memory reading device that the user of the present system desires to receive. The present invention includes a device located at the inaccessible location, which device includes the capabilities of processing and memory. In the present invention the portable reading device is portable and used by the user to receive instructions.

Thus, Want cannot anticipate Claim 29 and the dependents therefrom. See *MPEP 2131*. Consequently, Applicant traverses the 35 U.S.C. §102(b) rejection of Claim 29, deems it overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 29 is in a condition for allowance.

Applicant further submits that Want fails to teach, and therefore anticipate, Claims 30-31 and 33-40 at least because of these claims' ultimate dependence on

patentably distinct base Claim 29. Applicant submits that each of Claims 30-31 and 33-40 are similarly in a condition for allowance.

**Claim Rejections Pursuant to 35 U.S.C. §103**

Claims 5, 8 – 9, 20, 32 and 41 – 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Want (U.S. Patent No. 6,008,727). Applicant respectfully traverses these rejections for at least the following reasons.

35 USC §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Accordingly, MPEP 706.02(j) states:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant submits that Want fails to teach, and therefore anticipate or render unpatentable, Claims 5, 8-9, 20 and 32, at least because of these claims' ultimate dependence on patentably distinct base Claim 1, 16, or 29. Applicant submits that each of Claims 5, 8-9, 20 and 32 are similarly in a condition for allowance.

Want does not disclose a "portable reading device," nor does Want do anything "upon request of the user on the portable memory reading device," as is claimed in Claim 41. In Want, "the identification number of the read electronic tag is passed to the computer system" when "the electronic tags are brought near one or more of the tag readers." See Want Col. 6, lines 53-58.

Applicant further submits that Want fails to teach, and therefore anticipate or render unpatentable, Claim 41, at least because of the reasons set forth hereinabove with respect to Claims 1, 26 and 29.

Applicant further submits that Want fails to teach, and therefore anticipate or render unpatentable, Claims 42-48 at least because of these claims' ultimate

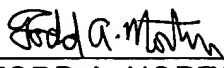
dependence on patentably distinct base Claim 41. Applicant submits that each of Claims 42-48 are similarly in a condition for allowance.

**Conclusion**

Applicant respectfully requests reconsideration of the present Application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

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